

U.S. Serial No. 09/490,495
Response to the Office Action Dated May 10, 2004

REMARKS

The applicant has carefully considered the Office action dated May 10, 2004 and the references it cites. By way of this Response, claims 242-244, 253-255, 263, 267-268, 275, 278-279, 284, 287, 290 and 291 have been amended, new claims 313-316 have been added, and claims 246, 256, 265, 276-277, and 285 have been cancelled without prejudice to their further prosecution. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

As an initial matter, the applicant respectfully thanks Examiner Nguyen and his supervisor, Examiner Jeffrey Smith, for their participation in a personal interview on June 30, 2004 with applicant's undersigned counsel. At the outset of the interview, the Examiners indicated that the 35 U.S.C. § 112 rejection and the rejections based on the PTO printer system made in the Office action of May 10, 2004 were withdrawn. Subsequently, the claims as presented in this response were discussed and it was agreed that the claims as presented in this Response are patentable over the Curran reference. During the interview, the Examiner asked the undersigned what he believed to be the closest prior art. The undersigned indicated that, in his personal opinion, the Krakatoa article (considered by the Examiner in connection with the information disclosure statement filed on May 1, 2001) was the closest prior art, but that it failed to disclose or suggest transferring monitoring information from a content display site to a remote site different from the content provider site. The Examiners agreed that there was no suggestion for modifying the

U.S. Serial No. 09/490,495
Response to the Office Action Dated May 10, 2004

Krakatoa personalized newspaper system to meet the claims as presented in this Response.

As discussed at the interview, dependent claims 243, 244, 254, 255, 267, 268, 278, 279, 290 and 291 are presented to make it clear that implementations of the claimed subject matter using computer languages which embed the monitoring instruction(s) in the content file by physically locating the monitoring instruction(s) in the content file (e.g., languages such as JavaScript) as well as computer languages which embed the monitoring instruction(s) in the content file by physically embedding a reference or link in the content file to request monitoring instruction(s) which reside external to the content file (e.g., languages such as Java) are both fully covered. Both approaches are disclosed and supported by the specification.

In view of the amendments filed herein, it is respectfully submitted that all of the rejections made in the Office action of May 10, 2004 are overcome, and this application is in condition for allowance.

Before closing, the applicant notes that the following amendments are narrowing:

1. In claims 242 and 253, the addition of the phrase "different from the content provider site."
2. In claim 263, the addition of the phrases "originally provided by a content provider" and "which did not provide the content file."
3. In claim 275, the addition of the phrases "from a content provider" and "transmitting the data signal to a remote site different from the content provider site."

U.S. Serial No. 09/490,495
Response to the Office Action Dated May 10, 2004

4. In claim 287, the addition of the phrase "at least one computer executable instruction that, when executed, causes data indicating the content was displayed to be transmitted to a remote site which did not supply the content file."

All of the other amendments made in this Response are either broadening or are merely clarifying in that the amended claim is intended to state the same thing as the claim prior to amendment (i.e., to have the same scope both before and after the amendments) in a more easily understood or more conventional fashion. Consequently, these broadening or clarifying amendments do not give rise to prosecution history estoppel or limit the scope of equivalents of the claims under the doctrine of equivalents.

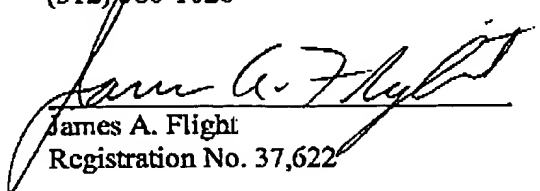
If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

If any fees are due in connection with this response, please charge them to deposit account no. 50-2455.

Respectfully submitted,

GROSSMAN & FLIGHT, LLC.
Suite 4220
20 North Wacker Drive
Chicago, Illinois 60606
(312) 580-1020

By:


James A. Flight
Registration No. 37,622

July 2, 2004

JUL 02 2004
GROUP 361